

REMARKS

We ask the Examiner to enter the un-entered amendment, a copy of which is enclosed herewith.

We have also enclosed another set of marked up drawings showing the changes that we had proposed in our previous response to address the Examiner's concerns. In his Advisory Action, the Examiner had reported that the drawings were not present in the submission that he found in the PTO file.

At the time of submitting our previous response, we also submitted an Information Disclosure Statement identifying three design patents. The Examiner chose not to consider those references. In his Advisory Action of January 31, 2002, he also noted that those design patents may provide the basis for a double patenting rejection when they are considered. We are surprised at that comment given that the standard for a double patenting rejection in a design-utility situations is rather high and those references do not meet it. According to the MPEP §1504.06 Section II:

...in design-utility situations, a two way obviousness determination is necessary for the rejection to be proper. *In re Dembiczak*, 175 F.3d 994,50 USPQ2d 1614 (Fed. Cir. 1999).

Thus, under the two-way test required in utility-design patent situations and articulated in Dembiczak, the rejection "is appropriate only if the claims of the two patents cross-read, meaning that 'the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, **and vica versa.**'" *Id.* at 1619 (emphasis added). That is, it is only the claims and not the disclosure or figures of the utility application that can be considered with respect to the design patent, since the disclosure of the "reference" patent may not be used as prior art. Indeed, the M.P.E.P. at §1504.06 (page 1500-41, rev. August, 2001) specifically requires "The Examiner must be able to recreate the design claimed from the utility claims without any reliance whatsoever on the design drawings." (emphasis added).

We submit that none of the claims of the present application render obvious any of the foil designs taught by the three design patents that we have submitted for the Examiner's consideration.

We participated in a telephone interview with the Examiner on April 2, 2002 to discuss the missing drawings and other issues. During that interview, the Examiner also indicated that he had trouble with new proposed dependent claim 57. He did not understand what was meant by "stress-free state." Though this specific phrase is not used in the specification, we submit that the person of ordinary skill in the art would understand what this meant, especially in view of the specification. More specifically, the person of skill in the art would recognize that "in a stress-free state" meant the absence of any externally imposed stresses to cause the foil to maintain its complex, three-dimensional shape.

The specification makes clear that a foil that is fabricated using the disclosed process maintains its complex three-dimensional shape when pulled off of the mandrel or substrate on which it is formed and before it is mounted on the shaving head. In the case of the foil illustrated in Fig. 1, this cannot be doubted, especially given the presence of the end skirts 118 and 119. But even in the absence of such end skirts, a careful reading of the specification would lead the skilled person to recognize that a foil that is fabricated with the claimed features (i.e., "a skin-engaging surface having both a convex elliptic region and a hyperbolic region") also maintains its complex shape without need to impose it externally. For example, the foil illustrated in Figs. 22 and 23, which has no end skirts, is shown as having the complex shape in a free-standing state and according to the specification:

Fig. 22 and 23 show a foil 281 which represents a modification of the foil of Figs. 1 to 4 in which the end cheeks 112 and 113 are omitted, so that the foil 281 has open ends. This results in somewhat reduced structural rigidity. Accordingly, the foil is mounted on a frame 282 of synthetic plastics material having lateral lugs 283, 284 for engagement in securing apertures 285, 286 on the side skirts of the foil 281. [emphasis added] (Page 12, lines 6-13).

That is, the foil shown in Fig. 22, like the foil shown in Fig. 1, has structural rigidity but it has that structural rigidity to a lesser degree. In other words, the foil maintains its complex shape without the need to externally force it into having that shape (i.e., while free-standing) but it will take less of a load before deforming away from that shape.

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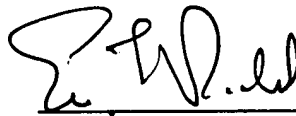
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We have also added in this filing a claim 58 which recites this "-stress-free" feature using alternative language. More specifically we substituted the phrase "when free-standing."

We ask that all claims be examined. Enclosed is a \$18 check for excess claim fees and a \$1440 check for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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